

REMARKS

Claims 1-3, 5, 6, 8-15, and 22 were pending in this application and were subject to a final rejection. Applicant cancels claims 1-3, 5, 6, 8-15, and 22 and reserves the right to pursue the subject matter of these claims in a continuation application. Applicant adds claims 23-40 to more clearly define the claimed subject matter.

Support for the new claims can be found in the specification as-filed, for example, at least at page 8, lines 3 to page 9, line 8; page 9, lines 14-17; page 11, lines 19-27, page 12, lines 4-14, page 13, lines 16-26; page 14, lines 3-6, page 15, lines 3-17, originally filed claims 1, 2, 5, 6, 7, 8, 9, 13, 14, 15, 29, Example 3 and Figure 1. No new matter is added.

Applicant respectfully submits that new claims 23 to 41 do not contain any of the terms objected to by the Examiner under 35 U.S.C. § 112, second paragraph, in the final Office Action. Accordingly, the basis of this rejection is rendered moot.

Moreover, Applicant respectfully submits that the new claims are also free of the prior art. A proper *prima facie* obviousness rejection requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Additionally, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Also, see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure).

The Examiner has cited Tolvanen et al. (J. Biol. Chem. 261(20): 9546-9551 (1986)) ("*Tolvanen*") and U.S. Patent No. 6,251,858 ("*Monsigny*") as a basis of the obviousness rejection. Applicant respectfully submits that not only is there no motivation to combine the teachings of *Tolvanen* and *Monsigny*, but even if these references were combined, their combination fails to teach or suggest each and every limitation of the claimed invention. Specifically, the Examiner has acknowledged that *Tolvanen* differs from Applicant's invention in that it does not suggest coupling of a phosphorylated oligosaccharide to a glycoprotein such as a lysosomal enzyme (4/16/04 Office Action at page 5). The Examiner has further acknowledged that *Monsigny* does not suggest a method of coupling an oxidized glycoprotein with a derivatized phosphorylated mannopyranosyl oligosaccharide. (4/16/04 Office Action at page 6). Therefore, neither *Tolvanen* nor *Monsigny* teaches or suggests coupling oligosaccharides to oxidized lysosomal enzymes, as required by claims 23-40. Further, Applicant notes that even if the phosphorylated oligomannosides of *Monsigny* were used in the method of *Tolvanen*, they would only result in the attachment of the oligomannosides to cell surface glycoconjugates, and not to lysosomal enzymes, as recited in claims 23-40.

Therefore, at least for these reasons, claims 23-40 are not obvious in view of either *Tolvanen* and *Monsigny*, alone or in combination.

Accordingly, Applicant requests that claims 23-40 be allowed.

Please grant any extensions of time required to enter this Amendment and
charge any required fees to deposit account 06-0916.

Respectfully submitted,

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